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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/433,139	11/03/1999	JOHN G. SAVAGE	8184.00	2123

26889 7590 03/06/2006

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EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

MAR 3 6 2006

Technology Center 2100

Application Number: 09/433,139
Filing Date: November 03, 1999
Appellant(s): SAVAGE ET AL.

Melvin H. Pollack
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09 January 2006 appealing from the Office action mailed 05 August 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,334,109	KANEVSKY et al.	12-2001
6,431,439	SUER et al.	08-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky et al. (6,334,109) in view of Suer et al. (6,431,439).
3. For claims 36 and 40, Kanevsky teaches a system (abstract) for operating a user device communicating with a transaction device (col. 1, line 1 – col. 4, line 45) with means for:
 - a. Executing a transaction (col. 5, lines 36-41);
 - b. Preparing data relating to the transaction that has been executed (col. 5, lines 36-41 in view of col. 7, line 65 – col. 8, line 40, wherein transaction-related data such as receipts and advertisements are provided to the user via printer or monitor display);
 - c. Transferring the prepared data to the user device to provide the customer with an electronic receipt for the transaction (col. 5, lines 36-41; col. 8, lines 39-40);
 - d. Receiving from the user device personal information which is unrelated to the transaction (col. 5, line 30 – col. 6, line 30) and which is associated with the customer when the electronic receipt is provided (col. 2, lines 41-42; col. 5, lines 40-43); and
 - e. Downloading to the user device specific information which is unrelated to the transaction and which is tailored to the customer based upon the received personal

information from the user device (col. 1, lines 54-55; col. 2, lines 2-15; col. 5, lines 44-47).

4. Kavensky fails to disclose that the user device is a portable device, retained by the customer, which establishes a wireless communication with the transaction device, wherein the transaction device is an Automated Teller Machine (ATM) and the transaction is the dispensation of cash. Suer teaches a method and system (abstract) of performing execution of transactions and development of user-related information (col. 1, line 1 – col. 5, line 25) wherein:
 - a. The user device is a portable device, retained by the customer, which establishes a wireless communication with the transaction device (col. 4, lines 30-34 in view of col. 6, lines 44-55);
 - b. The transaction device is an Automated Teller Machine (ATM) (col. 4, lines 30-34 in view of col. 6, lines 44-55); and
 - c. The transaction is the dispensation of cash (col. 6, lines 44-55).
5. At the time the invention was made, one of ordinary skill in the art would have readily recognized the desirability and advantages of modifying Kanevsky by employing the provision of personalized information to the user of an ATM via a portable device. This benefits the system because the user of an ATM may be in need of information relating to the area of the machine. Further, the system will address a larger number of users by branching out to ATMs in addition to other points of sale while the user may save the information to the portable device.

6. For claim 37, Kanevsky further teaches means for analyzing the personal information uploaded from the portable device, and storing the analyzed information in a database entry as a customer profile (col. 5, lines 20-23 in view of col. 1, lines 63-66).
7. Kanevsky does not expressly disclose that the user device is retained by the ATM customer. Suer teaches this limitation (col. 4, lines 30-34; col. 6, lines 44-55). At the time the invention was made, one of ordinary skill in the art would have modified Kanevsky via Suer's retention by providing further methods of advertisement and receipt data retention.
8. For claim 38, Kanevsky does not expressly disclose that the uploaded information is specifically schedule information from a calendar program. Suer teaches this limitation (col. 9, lines 48-52). At the time the invention was made, one of ordinary skill in the art would have modified Kanevsky via Suer for the reasons above.
9. For claim 39, Kanevsky does not expressly disclose means wherein the specific information downloaded to the portable device retained by the ATM customer relates to events or activities occurring in a location associated with the schedule information. Suer teaches this limitation (col. 9, lines 48-52). At the time the invention was made, one of ordinary skill in the art would have added Suer information to Kanevsky to further provide the user with local activities information of interest.

(10) Response to Argument

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Applicant's sole argument is that Kanevsky would be destroyed if combined with Suer (P. 5, lines 28-32) by characterizing Kanevsky as a system requiring a printer (P. 5, lines 20-23), while Suer requires a paperless transaction (P. 5, lines 24-28).

The examiner disagrees with the above interpretation. Specifically, Kanevsky clearly teaches a paperless financial transaction embodiment (claims 24, 29 and 34), and several independent claims (claims 1, 8, and 15) state only that the transaction data and advertisement data be communicated to the user, with no dependent claims specifying limits on how that data be transmitted. Kanevsky, at minimum, shows in the specification that the data may be communicated via a printed receipt and/or via a monitor display (col. 2, lines 8-11), and further allows for the addition or modification of user communications methods (col. 10, lines 63-67). Further, the addition of a paperless display is one of the objects of the invention (col. 1, lines 54-55). Therefore, Kanevsky not only does not specify a requirement in the specification for a printed receipt, but it also teaches a paperless embodiment that may be combined with other paperless embodiments.

As for Suer, while a paperless transaction is taught as preferable, at no point does Suer express or imply that the system cannot also utilize a printer or that a user cannot receive paper receipts. It only teaches toward a paperless communication in addition to any other communication, paperless or not.

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Further, in response to applicant's argument that a system with a printer may not be combined with a system without a printer, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Even if Kanevsky did not teach a paperless embodiment, neither the addition of a non-paper transmission nor the replacement of a printer with a paperless transmission would have destroyed the reference. Kanevsky would still be operable, and usable as described in the specification.

Therefore, the rejection stands.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Melvin H. Pollack


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